

REMARKS

Applicant has carefully reviewed the Office Action mailed February 2, 2006 and offers the following amendments and remarks.

Claim 10 has been amended to correct antecedent basis. Claim 14 has been amended to correct its dependency. No new matter has been added.

Claims 1-7, 9-11, 13-20, and 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas et al. (hereinafter "Thomas") in view of McCown et al. (hereinafter "McCown"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the rejections, Applicant provides a brief overview of the invention as background. The present invention relates to a portable device configured to interact with any number of host computing devices. The portable device primarily includes memory associated with an interface to facilitate interaction with the host computing devices. The portable device may include control circuitry to assist in interactions with the host computing devices, as well as to execute software and organize data stored thereon.

In operation, the portable device will initially appear to a host computing device as a known device type. The host computing device will be configured to interact with the portable device as the known device type. Upon such interaction, the host computing device will access indicia sufficient to identify the portable device as a second device type and instruct the host computing device to configure itself to interact with the portable device as the second device type. The second device type is preferably configured to provide a service for applications running on the host computing device. In a preferred embodiment, the second device type is a cryptographic service provider (CSP) capable of providing cryptography services for applications running on the host computing device. The known device type will preferably

emulate a mass storage device readily accessible and addressable by the host computing device upon recognition. Software or data provided in the memory of the device is preferably accessible and executable by the host computing device. The data may include keys for encryption/decryption, cryptography algorithms, and the like. Notably, portable devices equipped with processing capabilities may operate to provide processing for the services provided by the second device type on the portable device.

First, Applicant traverses the rejection because the Patent Office has not properly supported the proposed combination. The Patent Office asserts that it would have obvious to combine Thomas with McCown “because configuring the host computer to run the applications from the portable device allows a user to maintain everything he or she needs, while using a portable disk (see col. 4, lines 8-16 of Thomas et al.). The added benefit of cryptography services provided to the host computing device allows an end-to-end encryption of data to ensure all data is stored encrypted (see abstract of McCown et al.)” (Office Action mailed February 2, 2006, p. 4). The alleged motivation to combine is faulty and lacks actual evidence. The first sentence of the Patent Office’s alleged motivation to combine merely states that Thomas discloses a removable disk which contains application software to be run on a PC, which allows a user to maintain what he or she needs on the removable disk. The second sentence of the proposed motivation simply restates that McCown discloses an encryption system which permits end-to-end encryption of information over an untrusted interconnection network. What is lacking in the Examiner’s alleged motivation is why one of ordinary skill in the art looking at the system of Thomas would be motivated to look to the encryption system of McCown; in fact, the Patent Office has failed to even indicate why Thomas would need encryption. Moreover, the Examiner has failed to support the alleged motivation to combine with any actual evidence, as is required by Federal Circuit law. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Since the stated motivation to combine Thomas and McCown is faulty and lacks the requisite actual evidence, the stated motivation is improper. Since the stated motivation is improper, the proposed combination is improper. Since the proposed combination is improper, and the references individually do not teach or suggest each and every element of the claims, the claims are patentable.

Even if the proposed combination is proper, a point Applicant does not concede, the combination does not teach or suggest each and every element of the claimed invention. Claim 1

recites as limitations “configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type” and “wherein the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type, wherein the second device type is a cryptographic service provider.” The Examiner admits that these limitations are not taught by Thomas, but cites to McCown as allegedly teaching these limitations (Office Action mailed February 2, 2006, pp. 3-4).

In particular, the Examiner points to col. 4, lines 12-23 and lines 56-67 of McCown. The portions of McCown pointed to by the Examiner disclose an encryption system that includes a client connected through an encryption module 24 to at least one storage device. The encryption module 24 includes a first processor accessing a first memory for communicating with the client and a second processor accessing a second memory for communicating with the storage device. The first processor handles unencrypted information and stores it in the first memory. The second processor obtains a data key from a key server, receives unencrypted information from the first processor over a dedicated channel, and encrypts the information using the data key and stores it in a storage device. The second processor can also decrypt the information using the data key and send the decrypted information to the first processor over the dedicated channel. In one embodiment, the encryption module is not connected to the network and the second processor can perform the functions of the key server.

Although McCown does disclose an encryption system, McCown does not teach or suggest a portable device having a memory within a body containing “configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type.” It is not clear what portion of McCown is being equated to the portable device, nor is there mention of a first and second device type. In addition, there is no specific indication provided by the Examiner as to what constitutes the configuration indicia to subsequently identify the portable device to the host computing device as a second device type. In any event, there is no teaching or suggestion in McCown of instructions being provided to allow the host computing device to effectively interact with the portable device as the second device type, as recited in claim 1. Since McCown does not teach or suggest the

element for which it is cited, and the Patent Office admits that Thomas does not teach this element, the combination of Thomas and McCown does not teach or suggest “configuration indicia to subsequently identify the portable device to the host computing device as a second device type and provide configuration instructions to allow the host computing device to effectively interact with the portable device as the second device type.” Since the combination does not teach or suggest each and every element of the claim, claim 1 is allowable.

Moreover, although McCown does disclose an encryption system, this is not a teaching of the claimed invention. Claim 1 recites that the second device type is a cryptographic service provider. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, that interpretation is determined from the point of view of someone of ordinary skill in the art and must be consistent with the specification. MPEP § 2111. Regardless of the point of view, **reasonable** is the operative part of the standard. The encryption system disclosed by McCown is not equivalent to the claimed cryptographic service provider (“CSP”). The CSP, as described in the specification, is known to one of ordinary skill in the art as a specialized service used to implement desired cryptographic standards and algorithms and typically consists of a dynamic-link library (DLL) that implements defined functions in a system program interface, such as Microsoft Crypto SPI. CSPs typically cooperate with a cryptography application program interface (API) to serve cryptography functions required by applications (Specification, paragraph 0003). The present invention claims a portable device configured to automatically interact with a host to install and register cryptography services for use by applications capable of running on the host (Specification, paragraph 0019). In contrast, McCown teaches an encryption module associated with a client that actually separates the client from the encryption process such that the client does not have direct contact with, and does not handle, the encryption and decryption keys. McCown, col. 2, lines 10-23. Given the teaching of McCown, it follows that McCown does not teach or suggest the claimed cryptography service provider, and therefore, does not teach or suggest “wherein the host computing device will detect the portable device as being the first device type and subsequently configure itself to interact with the second device type, **wherein the second device type is a cryptographic service provider.**” Since McCown does not teach or suggest the element for which it is cited, and the Patent Office admits that Thomas does not teach this element, the combination of Thomas and McCown does not teach or suggest “wherein the host computing device will detect the portable

device as being the first device type and subsequently configure itself to interact with the second device type, wherein the second device type is a cryptographic service provider.” Since the combination does not teach this element of the claim, claim 1 is allowable for this additional reason.

Claims 2-7, 9-11, and 24-26 depend from claim 1 and contain all the limitations of claim 1. Therefore, claims 2-7, 9-11, and 24-26 are patentable for at least the same reasons as set forth above with respect to claim 1. Claims 13 and 23 are independent claims that contain limitations similar to those found in claim 1, and are therefore patentable for at least the same reasons as set forth above with respect to claim 1. Claims 14-16 depend from claim 13 and are allowable for at least the same reasons.

Claim 17 is directed to a method and recites several steps, including: automatically identifying the portable device to the host computing device as a second device type; enabling the portable device as the second device type with the host computing device based on information provided on the portable device; and providing a service corresponding to the second device type for applications running on the host computing device based on the information provided by the portable device. Claim 22 is also a method claim and is similar to claim 17, with claim 22 specifically claiming a cryptographic service provider as the second device type. The Examiner admits that Thomas does not teach these claim steps, but cites to McCown as allegedly teaching the missing elements.

As set forth above, the combination of Thomas and McCown is improper and therefore should be withdrawn. In addition, claims 17 and 22 contain limitations similar to those in claim 1, and are patentable for at least the same reasons set forth above with respect to claim 1. Moreover, even if combined, a point Applicant does not concede, the combination of Thomas and McCown does not teach or suggest each and every element of claims 17 and 22. McCown does not teach or suggest automatically identifying the portable device to the host computing device as a second device type and enabling the portable device as the second device type with the host computing device based on information provided on the portable device. McCown discloses an encryption system which permits end-to-end encryption of information over an untrusted interconnection network. Thomas teaches a removable disk which contains application software to be run on a PC, which allows a user to maintain what he or she needs on the removable disk. Thus, even if Thomas and McCown were combined, at best the combination

would be a removable disk which contains application software and an encryption system to be run on a PC. The combination would not disclose or suggest a method whereby a single portable device is identified to, and registered with, a host computing device as a first device type known to the host computing device, and then is subsequently automatically identified as a second device type (CSP) to the host computing device, is enabled as the second device type (CSP) with the host computing device based on information provided by the portable device, and provides a service (cryptography service) corresponding to the second device type for applications running on the host computing device based on information provided by the portable device. There is no teaching or suggestion in Thomas or McCown, alone or in combination, that a single portable device is identified as a first device type and then subsequently automatically identified and enabled as a second device type, such as a CSP. In other words, there is no teaching or suggestion of how, even if Thomas and McCown were combined, the removable disk of Thomas would first be recognized by the host as an application software disk and then subsequently automatically be recognized as containing an encryption module. Therefore, the combination of Thomas and McCown does not teach or suggest a method that includes: identifying a portable device to a host computing device as a first device type, which is known to the host computing device; registering the portable device with host computing device as the first device type; automatically identifying the portable device to the host computing device as a second device type; enabling the portable device as the second device type with the host computing device based on information provided on the portable device; and providing a service corresponding to the second device type for applications running on the host computing device based on the information provided by the portable device, as is required by claims 17 and 22. Since the combination does not teach or suggest each and every element of claims 17 and 22, these claims are allowable.

Claims 18-20 depend from claim 17 and contain all the limitations of claim 17. Therefore, claims 18-20 are patentable for at least the same reasons as set forth above with respect to claim 17.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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